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OFFICE OF PETITIONS

In re Application of :
Walker, Jorasch, Fincham, Krantz, : DECISION REFUSING STATUS
Garcia, Gelman, Tedesco, and Tulley: UNDER 37 CFR 1.47(a)
Application No. 10/619,066 :
Filed: 14 July, 2003 :
Atty Docket No. 03-041 :

This is in response to the petition filed under 37 CFR 1.47(a) on 20 January, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 14 July, 2003, without an executed oath or declaration. Accordingly, on 14 October, 2003, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on 20 January, 2004 (certificate of mailing date 14 January, 2004), petitioners filed a declaration naming Jay S. Walker, James A. Jorasch, Magdalena M. Fincham, Jason Krantz, Victor M. Garcia, Geoffrey M. Gelman, Daniel E. Tedesco, and Stephen C. Tully as joint inventors, signed by all joint inventors except Garcia on behalf of themselves and on behalf of joint inventor Garcia, the present petition, petition fee, and the late-filing surcharge.

Petitioners state that joint inventor Garcia refused by telephone to sign any documents related to the application.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1).

In regards to item (1), petitioners have not provided proof that joint inventor Garcia was ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).¹

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact. While petitioners have presented an affidavit attesting to an unwillingness on the part of Garcia to join in the filing of the application papers, Garcia must nonetheless must be afforded an opportunity to review the application papers. Petitioners should send or give the non-signing inventors a copy of the application papers as specified above at their respective last known addresses with a request that they sign and return the declaration.

¹MPEP 409.03(d).



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